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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/180,340	08/20/1999	NANCY W.Y. HO	7024109PUR48	6674

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EXAMINER
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ROBINSON, HOPE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 08/05/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/180,340**

Applicant(s)  
**Ho et al.**

Examiner  
**Hope Robinson**

Art Unit  
**1653**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 18, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. PCT/US97/07663.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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### **DETAILED ACTION**

1. Applicant's response to the Office Action mailed April 12, 2002 in Paper No. 11 on January 18, 2002 is acknowledged. It is noted that the Petition filed to revive this application has been granted.
2. Claim 13 has been amended. Claims 1-30 are pending.
3. The following grounds of rejection are or remain applicable :

#### ***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-13 are rejected under 35 U.S.C. 102 (a) as being anticipated by Ho et al. (WO95/13362, May 18, 1995).

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Ho et al. teach recombinant yeasts containing genes encoding xylose reductase, xylitol dehydrogenase and xylulokinase, and DNA molecules, vectors and methods useful for producing such yeasts. The recombinant yeasts effectively ferment xylose to ethanol, and preferred yeasts are capable of simultaneously fermenting glucose and xylose to ethanol thereby taking full advantage of these two sugar sources as they are found in agricultural biomass (see abstract and page 3). The reference also teach the fermentation of glucose to ethanol via the yeast *Saccharomyces* (see pages 3-5). Ho et al. indicate that the yeast of the invention can ferment the two sugars (xylose and glucose) to ethanol simultaneously achieved where the xylitol dehydrogenase, xylulokinase and xylose reductase genes are fused to promoters which are not inhibited by the presence of glucose and also do not require xylose for induction (see page 6). In addition, the recombinant yeast strain containing xylitol dehydrogenase, xylulokinase and xylose reductase genes are fused to non-glucose-inhibited promoters and the yeast is capable of fermenting xylose to ethanol and glucose to ethanol (see page 6). The genes that are fused to promoters in the above case are not inhibited by glucose and do not require xylose for induction, so as to enable the expedient production of recombinant yeasts capable of simultaneously fermenting glucose and xylose to ethanol (see page 7).

Ho et al. teach direct amplification of the intact xylitol dehydrogenase gene and the promotor less xylitol dehydrogenase from *Pichia stipitis* chromosomal DNA (see Figure 10 and page 10). Furthermore, Ho et al. disclose that suitable sources of xylitol dehydrogenase, and xylose reductase genes include xylose-utilizing yeasts such as *Candida shehatae*, *Pichia stipitis*,

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*Pachysolen tannophilus* and suitable sources of xylulokinase genes include the above yeasts as well as xylose non-utilizing yeasts such as those from genus *Saccharomyces cerevisiae*, *Schizosaccharomyces pombe* and bacteria such as *Escherichia coli* etc. (see page 13).

Additionally, the reference teaches that pLSK15, a derivative of pLX10-14 is a low copy number plasmid with a copy number of approximately 10 in yeast (*Saccharomyces*). pLSK15 contains the geneticin resistance gene and ampicillin resistance gene which serve as selection markers in *S. cerevisiae* (see pages 15 and 16). pUCKm10 another high copy number plasmid (copy number of about 50 or more) with a copy number close to 100 in *S. cerevisiae*. These specific DNA fragments serve as the replicon and selection markers that enable the plasmid to be replicated autonomously in *S. cerevisiae* and other yeast and enable the yeast transformants containing the plasmid to be distinguished from the untransformed host cells (see page 16). Therefore, the limitations of the claims are met by Ho et al.

5. Claims 14-16, 18-19 and 28 are rejected under 35 U.S.C. 102 (b) as being anticipated by Le Dall et al. (Current Genetics, vol. 26, pages 38-44, 1994).

Le Dall et al. disclose the construction of several plasmids to test gene amplification in the rDNA by using an EcoRI-Bgl/II fragment of the G unit of the rDNA of *Y. lipolytica*. The reference provides a plasmid containing Ura3 gene, and the XPR2 gene encoding alkaline extracellular proteinase integrated into a ribosomal RNA gene of *Y. lipolytica*. Le Dall et al. tested transformants containing plasmids for copy number, stability, chromosomal localization and

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alkaline extracellular protease secretion. Multiple copies of the plasmid were successfully integrated into the genome and cells which expressed the Ura3 gene could be maintained in non-selective medium for at least 20 generations. Further Le Dall et al. asserts that the plasmids contain a portion of the rDNA of *Y. lipolytica* as well as derivatives of the *Y. lipolytica* URA3 gene as selection markers. These derivatives contain various promoter deletions either coupled, or not coupled, to a mutation in the coding region. In addition, these plasmids contained the XPR2 gene used as a model for gene expression and protein secretion (see abstract, and pages 38-39 and 43-44). Therefore, the limitations of the claims are met by this reference.

6. Claims 14-16, 18, 19, 28 and 30 are rejected under 35 U.S.C. 102 (a) as being anticipated by Lopes et al. (Yeast, vol. 12, no.5, pages 467-477, April 1996).

Lopes et al. teach numerous plasmid containing various genes integrated into a ribosomal RNA gene of *Saccharomyces cerevisiae*. Multiple copies of the plasmid were successfully integrated into the genome; cells were maintained in non-selective medium for multiple generations and stability of the integrated genes was assessed (see abstract and pages 467-475). Further, the plasmids contained a Leu2d selection marker and various cloned genes for stability and expression studies. Yeast transformants were selected by plating on agar plates containing yeast nitrogen base (without amino acids), glucose and histidine. The same medium was used for growing the transformants in liquid culture (see page 468 and Figure 1). Therefore, the claim limitations are met by this reference.

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7. Claims 14-16, 18, 19, 28 and 30 are rejected under 35 U.S.C. 102 (b) as being anticipated by Fujii et al. (Applied and Environmental Microbiology, vol. 56, no. 4, pages 997-1003, April 1990).

Fujii et al. teach an integration plasmid, pIARL28 containing the ribosomal DNA gene constructed for introduction of the  $\alpha$ -acetolactate decarboxylase gene into brewer's yeast. The transformation efficiency of pIARL28 was 20-50 fold higher than those of other Yip vectors, as yeast cells had approximately 140 copies of the ribosomal DNA gene (see abstract and pages 997-998). The reference also teach that multiple copies of the plasmid was successfully integrated into the genome of a strain of brewer's yeast; cells which expressed the exogenous gene at low levels and had excised the marker sequences could be maintained in non-selective medium for over 80 generations. Furthermore, integrants were selected on the basis of uracil prototrophy or resistance to G418, respectively. The number of transformants obtained with the KpnI-linearized plasmid was more than 20-50 fold higher than that obtained with the ApaI-linearized plasmid. Fujii et al. interpret these results to mean that the rDNA genes were useful target sequences because they enhanced integration efficiency due to their high copy number in the genome (see page 998, and Figure 1). Therefore, this reference meets the limitations of the claims.

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***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103 (a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 (c) and potential 35 U.S.C. 102 (f) or (g) prior art under 35 U.S.C. 103 (a).

9. Claims 1-30 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Yamano et al. (Journal of Biotechnology, vol. 32, pages 173-178, 1994) in view of Le Dall et al. (Current Genetics, vol. 26, pages 38-44, 1994), Fujii et al. (Applied and Environmental Microbiology, vol.



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56, no. 4, pages 997-1003, April 1990) and Tantirungkij et al. (Applied Microbiology Biotechnology, vol. 41, pages 8-12, 1994).

The teachings of Le Dall et al. and Fujii et al. are above. Yamano et al. disclose a plasmid containing an *Acetobacter aceti* ssp. *xylinum*  $\alpha$ -acetolactate decarboxylase (ALDC) gene integrated into a ribosomal RNA gene of brewer's yeast (*Saccharomyces carlsbergensis*; ribosomal genes are known to integrate as multiple copies). The plasmid was successfully integrated into the genome of a strain of brewer's yeast and cells which expressed the exogenous gene could be maintained in non-selective medium for over 60 generations. Further the cells were co-transformed with a plasmid for G418 resistance (pZNEO) (see abstract and pages 173-178). Yamano et al. teach that the proportion of ALDC positive clones was highest when the ratio of the ALDC integration cassette to pZNEO was 3:1 (see pages 177-178). Neither Le Dall et al., Fujii et al. or Yamano et al. teach a yeast containing genes for xylose fermentation multiply integrated into the ribosomal genes.

Tantirungkij et al. mutants of xylose-assimilating recombinant *Saccharomyces cerevisiae* carrying the xylose reductase and xylitol dehydrogenase genes on plasmid pEXGD8 were selected. High xylulokinase activity was reported in the fastest growing strain (IM2). Further, the reference teach that the slow conversion of xylose to xylitol led to an increase in the ethanol yield (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art to arrive at the invention as a whole by combining the teachings of the above references because Le Dall et al.,

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Fujii et al. and Yamano et al. all teach plasmids containing various genes integrated into a ribosomal RNA gene of brewer's yeast and multiple copies of the plasmid integrated into the genome. There is motivation to combine the references based on the similarity of the teachings and Fujii et al. incorporates the teachings of Yamano et al. In order to obtain a higher copy number of the genes for xylose assimilation and thus higher expression levels than observed by Tantirungkij et al. it would have been obvious to modify the teachings of Fujii et al., Le Dall et al. and Yamano et al. by adding in the xylose-assimilating recombinant yeast of Tantirungkij et al. Because Tantirungkij et al. describes recombinant *Saccharomyces cerevisiae* which contain and express the genes for xylose assimilation integrated into the genome. Although Tantirungkij et al. does not teach integration into ribosomal genes it would have been obvious for one of ordinary skill in the art at the time the invention was made to place the xylose assimilation genes into a ribosomal integration vector, as taught by Yamano et al., Le Dall et al. and Fujii et al. with a reasonable expectation of success. Thus, the claimed invention was obvious to make and use at the time it was made and was *prima facie* obvious.

10. Claims 1-30 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Ho et al. (WO 95/13362, May 18, 1995) in view of Le Dall et al. (Current Genetics, vol. 26, pages 38-44, 1994), and Fujii et al. (Applied and Environmental Microbiology, vol. 56, no. 4, pages 997-1003, April 1990).

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The teachings of Le Dall et al. and Fujii et al. are discussed above. Neither Le Dall et al. or Fujii et al. describes yeast containing the genes for xylose fermentation multiply integrated into the ribosomal genes. Ho et al. as applied to Claims 1-13 is above and is applied to this rejection in summary. Ho et al. discloses recombinant *Saccharomyces cerevisiae* which contain and express the genes for xylose assimilation integrated into the genome. Therefore, it would have been obvious to one of ordinary skill to place the xylose assimilation genes of Ho et al. into the ribosomal vector of Le Dall et al. and Fujii et al. with a reasonable expectation of success.

Thus, the claimed invention was obvious to make and use at the time it was made and was *prima facie* obvious.

11. Applicant's arguments filed January 18, 2002 in Paper No. 11 has been considered. Note that the rejections of record under 35 U.S.C. 102 and 103 remains. However, the rejection under 35 U.S.C. 112, second paragraph has been withdrawn. Regarding the rejection under 35 U.S.C. 102(a) applicant contends that Ho et al. does not teach or suggest a "gene integrated at each of multiple reiterated ribosomal DNA sites and that Ho et al. teaches recombinant yeasts which were created by cloning the three xylose metabolizing genes". However, the Ho et al. reference states that their method includes the step of introducing DNA into a yeast so as to cause the yeast to have introduced genes encoding xylose reductase etc. (see page 7). Thus, the reference does teach gene integration, therefore, the rejection has been maintained.

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Further, applicant's contend that claims 14-16, 18-19 and 28 should not be rejected under 35 U.S.C. 102(b and a) over Le Dall et al., Fujii et al. or Lopes et al., because the references do not teach or suggest a method of integrating multiple copies of exogenous DNA into reiterated chromosomal DNA of cells... (see page 3 of the response)". However, this statement is incorrect, see for example the Le Dall et al. reference which discloses that integrations occurred (multiple). The reference also states that the plasmids used contained the rDNA fragment for integration (see pages 38-42). In addition, Fujii et al. teaches integration (multiple) plasmids containing the ribosomal DNA gene constructed for introduction into brewer's yeast (see page 997). See also page 467 of the reference by Lopes et al. Thus, applicant's arguments are not persuasive and the rejections remain.

With regard to the rejection under 35 U.S.C. 103(a), the relevance of the Le Dall and Fujii references is stated above as applied under 35 U.S.C. 102. Applicant contends that the Yamano et al. and Tantirungkij references do not teach the claimed invention as the references do not utilize a replicative plasmid that includes the exogenous DNA to be introduced into the cell. Applicant further state that Yamano teaches introduction of exogenous DNA, that is incorporated into a plasmid, into brewer's yeast genome. However, this argument is not persuasive as the references are to be considered in combination not singularly. Further, as stated above the Fujii and Le Dall references teach multiple integration into the rDNA. Note that only claim 3 recites the type of yeast. Applicant also contends that the Tantirungkij reference utilized a vastly different method to increase the fermentation capacity in yeast, however, this is not a limitation in the

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claims, thus, not convincing. Regarding the rejection under 35 U.S.C. 103(a) over Ho et al., the relevance of the references has already been addressed above. Therefore, the rejection of record is maintained.

*Conclusion*

12. Applicant's amendment necessitated the new/modified ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. No claims are allowable.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope Robinson whose telephone number is (703) 308-6231. The examiner can normally be reached on Monday and Wednesday-Friday from 9:00 am to 5:30 pm (EST).

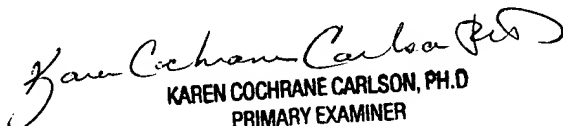
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S.F. Low, can be reached at (703) 308-2923.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-4242. Please affix the examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Hope Robinson, MS 

Patent Examiner

  
KAREN COCHRANE CARLSON, PH.D  
PRIMARY EXAMINER